

REMARKS

In the Office Action dated June 18, 2003, claims 1-6 and 8-13 were rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification fails to comply with the written description and enablement requirements. Claims 1-6 were further rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,662,552 to Uyehara. Claims 8-13 were further rejected under 35 U.S.C. § 103(a) as obvious over Uyehara in view of either U.S. Patent No. 5,386,932 to Gross or U.S. Patent No. 5,497,921 to Dancyger et al.

Applicant has amended the drawing by adding a reference numeral (20) which refers to an end of the loop. Applicant has made a corresponding amendment to paragraph [0020] of the written description to particularly call out and describe the end of the loop (20) element. The description of the end of the loop attaching to the top edge of the tubular body portion was depicted in the drawing as originally submitted with the present application. The function of the loop when attached to a belt, is drawn from paragraph [0014]. Thus, Applicant has introduced no new matter by way of these amendments to the drawing and specification.

Amended claim 1 now includes the limitation of "a flexible loop affixed to the tubular body portion". As amended, claim 1 complies with the written description and enablement requirements of 35 U.S.C. § 112, first paragraph. The amendments to the specification and drawing, as detailed above, clarify the scope of the disclosure and, therefore, ensure compliance with the written description and enablement requirements.

For the same reasons, claims 2-6, each of which ultimately depends from amended claim 1, also meet the written description and enablement requirements of 35 U.S.C. § 112, first paragraph.

Amended claim 8, includes similar, but narrower, limitations as compared to amended claim 1. Amended claim 8 recites the limitation that the means for attachment includes "only one flexible loop with an end thereof affixed to a top edge of the tubular

BEST AVAILABLE C

body portion". As to the "only one flexible loop" limitation, the drawing shows the means for attachment as a single, flexible loop attached to the tubular body portion. The written description describes the means for attachment as flexible loop in paragraph [0020], with reference to the drawing. The specification neither limits the means for attachment to only one flexible loop nor requires it to include more than one flexible loop. The specification and drawing thus fully describe and enable the "only one flexible loop" limitation.

Moreover, claim 1 as originally submitted with the present application recited the means for attachment without the "loop" limitation. In comparison, amended claim 8, with the "only one flexible loop" limitation, is narrower in scope than claim 1 as originally submitted because of the limitation on the number of loops. Therefore, where the specification complied with the written description and enablement requirements for claim 1 as originally submitted, it certainly satisfies these requirements for the narrower amended claim 8. The "only one flexible loop" limitation of amended claim 8 is thus fully supported by the drawing and the specification, the combination of which comply with the written description and enablement requirements of 35 U.S.C. § 112, first paragraph.

The specification also complies with the written description and enablement requirements in regards to the additionally added limitation of amended claim 8, namely the limitation wherein the only one flexible loop has "an end thereof affixed to a top edge of the tubular body portion", for the same reasons stated above in relation to amended claim 1.

For the reasons just stated in reference to amended claim 8, claims 9-13, each of which ultimately depends from amended claim 8, also meet the written description and enablement requirements of 35 U.S.C. § 112, first paragraph.

Claims 1-6 were rejected as anticipated by Uyehara. Rejections based upon anticipation must meet the requirement that every limitation of the rejected claim is

found in the prior art reference. See MPEP § 2131. Amended claim 1 now recites the limitation that the means for attachment includes “a flexible loop affixed to the tubular body portion”. Uyehara does not disclose this limitation. Referring to Figs. 1-7 of Uyehara, a baton holder (10) is disclosed which includes a tubular body portion (30) rotatably affixed to a base support (20). Webbing (50, 51) is threaded through slots (26) in the base support (20) and used to secure the base support (20) to the belt of a user. Importantly, the webbing (50, 51) does not affix directly to the tubular body portion (30), rather, it is affixed to the base support (20). Thus, Uyehara does not disclose the limitation of amended claim 1, recited as “a flexible loop attached to the tubular body portion”, and does not anticipate amended claim 1.

Likewise, where amended claim 1 is not anticipated, neither are dependent claims 2-6 anticipated.

Claims 8-13 were rejected as obvious over Uyehara in view of either Gross or Dancyger et al. In order to establish a *prima facie* case of obviousness, the cited references must teach or suggest each and every limitation of the rejected claim. See MPEP § 2142. Amended claim 8 includes the limitation of “only one flexible loop with an end thereof affixed to a top edge of the tubular body portion”. As discussed above in reference to amended claim 1, Uyehara does not teach or suggest the limitation of affixing the loop to the tubular body portion. Uyehara therefore does not teach or suggest this limitation of amended claim 8.

Furthermore, attaching the loops to the tubular body portion of the Uyehara invention would prevent rotation of the baton and defeat the purpose of the disclosed invention, namely a baton holder which is capable of rotating the baton out of the user's way so that it does not interfere with walking, running, crawling, etc. See Col. 1, ll. 39-61. Uyehara thus also teaches away from this limitation of amended claim 8.

Neither Gross nor Dancyger et al. fill these holes in the teachings of Uyehara. Each are cited in the Office Action for the proposition that a single flexible strap was

previously known in the art. For these reasons, the combination of Uyehara and either Gross or Dancyger et al. do not establish a *prima facie* case of obviousness over amended claim 8 or claims 9-13, each of which ultimately depends therefrom.

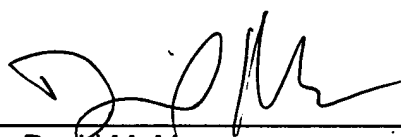
Based on the foregoing, claims 1-6 and 8-13 are believed to be in a form suitable for allowance and such is earnestly solicited.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

DATE: February 18, 2004

By: _____



David M. Morse
Reg. No. 50,505

Fulbright & Jaworski L.L.P.
865 South Figueroa Street
Twenty-Ninth Floor
Los Angeles, California 90017-2576
(213) 892-9200

BEST AVAILABLE COPY